

REMARKS

The amended title of the invention has been corrected to include markings in response to the Notice of Non-Compliant Amendment mailed on December 1, 2008. Otherwise, this response is identical to the response previously filed on November 7, 2008.

Claims 1, 4-5, 7, and 10-11 have been amended. Claims 6, 8, 10, and 12-19 have been cancelled. Claims 1-5, 7, 9, and 11 are pending and under consideration.

Favorable reconsideration of this application, in light of the following discussion and in view of the present amendment, is respectfully requested.

I. Objection to the Specification

In the Office Action, at page 4, the title of the invention was objected to. The title has been replaced with the title recommended by the Examiner. Accordingly, Withdrawal of this objection is respectfully requested.

II. Rejections under 35 U.S.C. § 103

In the Office Action, at pages 5-9, claims 1, 3-4, 6-7, and 9-10 were rejected under 35 USC § 103(a) as being unpatentable over Tamagaki et al. (U.S. Patent No. 5,452,105) in view of Kanno et al. (U.S. Patent No. 6,263,118).

In the Office Action, at pages 9-11, claims 2 and 8 were rejected under 35 USC § 103(a) as being unpatentable over Tamagaki et al. in view of Kanno et al. and further in view of Toshihiro (JP 9-200507).

Neither Tamagaki et al. nor Kanno et al. discuss or suggest:

an image reading unit configured to receive a medium including a colorless and transparent carrier sheet that includes a combination instruction mark in a predetermined position thereon and holds an original therein and configured to read a front side image and a rear side image from a front side and a rear side of the original, respectively;

a mark detecting unit detecting the combination instruction mark present in the predetermined position; and

an image combining unit combining a front side sliced image and a rear side sliced image sliced from predetermined positions of the front side image and the rear side image in a predetermined direction to obtain one image when the combination instruction mark is detected,

as recited in amended claim 1. In other words, the image reading unit of claim 1 receives a medium that includes a transparent carrier sheet that includes a combination instruction mark located thereon and the carrier sheet holds an original that contains images on both sides that are read by the image reading unit. Thereafter, the mark detecting unit detects the combination instruction mark and the image combining unit combines the images when the combination instruction mark is detected.

Tamagaki et al., as relied on by the Examiner, provides for carrying out a joining operation based on the presence of marks on the documents to be joined. However, these marks are “directly put on the documents by the use of a pen having a specified color” (Tamagaki et al., col. 19, lines 32-33). This is in contrast to claim 1, which instead provides for the combination instruction mark to be placed on the carrier sheet that holds the original document containing the images to be combined. In this manner, the invention of claim 1 maintains the integrity of the original document. None of the other cited prior art references, including Kanno et al. and Toshihiro, make up for this deficiency in Tamagaki et al., so that claim 1 patentably distinguishes over the cited prior art. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 2-5 depend either directly or indirectly from claim 1, and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 2-5 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

None of the cited prior art discusses or suggests:

at the image reading unit, receiving a medium including a colorless and transparent carrier sheet that includes a combination instruction mark in a predetermined position thereon and holds an original therein and reading a front side image and a rear side image from a front side and a rear side of the original, respectively; detecting, by the mark detecting unit, a combination instruction mark present in the predetermined position; and combining, by the image combining unit, a front side sliced image and a rear side sliced image sliced from predetermined positions of the front side image and the rear side image to obtain one image when the combination instruction mark is detected,

as recited in amended claim 7, so that claim 7 patentably distinguishes over the cited prior art. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 9 and 11 depend either directly or indirectly from claim 7, and include all the features of claim 7, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 9 and 11 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date:

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